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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** Shen et al.  
**Serial No.:** 10/570913 **Case No.:** 21437YP  
**Filed:** March 01, 2006  
**For:** Ophthalmic Compositions for Treating Ocular Hypertension

Art Unit  
1625

**Author:** T. S. [Signature]  
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MERCK & CO., INC.

By *Charles [Signature]* Date *12/6/07*

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Alexandria, VA 22313-1450

RESPONSE TO REQUIREMENT FOR RESTRICTION

Sir:

This is a response to the restriction requirement of November 19, 2007 for which a response is required December 19, 2007. Claims 1-19 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I. Claims 1-11 drawn to examples 1-2, 5-9, 14-15, 17, 19-20, 23-27, 32, 34-37, 40-44, 49-51, 54-58 and 63, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses,

Group II. Claims 1-11, drawn to examples 3-4, 21-22, 38-39, 52-53, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses,

Group III. Claims 1-11, drawn to examples 10-11, 28-29, 45-46, 59-60, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses,

Group IV. Claims 1-11, drawn to examples 12-13, 30-31, 47-48, 61-62, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses,

Group V. Claims 1-11, drawn to examples 16, 18, 33, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses,

Group VI. Claims 1-11, drawn to none of the examples above but other compounds within the scope of claim 1, and

Group VII. Claims 12-19, drawn to methods of using compounds of groups I-VI, classifiable in several non-heterocyclic classes (558, 562, etc.,) numerous subclasses.

Applicants elect Group I, Claims 1-11, drawn to examples 1-2, 5-9, 14-15, 17, 19-20, 23-27, 32, 34-37, 40-44, 49-51, 54-58 and 63 of formula I classified in classes 558, 562 and numerous subclasses with traverse. Applicants further elect the species of Example 8. The Examiner asserts that the restriction is proper because the inventions listed in Groups I to VII do not relate to a single general inventive concept under PCT Rule 13.1 in that they lack the same or corresponding technical features.

Applicants respectfully submit that the Examiner fails to justify the restriction requirement as the present invention of Groups I-VII are related. Even though only one invention may be claimed in a single application, a reasonable number of species of the invention can be claimed if there is an allowable generic claim in the application, which is the case of the present application. Accordingly, there is no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Moreover, a more careful review of Groups I through IV will reveal that all of the compounds are amides primarily substituted by alkyls or substituted alkyls which can also be combine with the nitrogen they are attached to form a ring. For example, compound 1 (Group I) is an amide substituted with 2 butyl groups, and compounds 3, 21, 38 (Group II) are amides substituted by cyclopropyl methyl and propyl groups. Likewise, compounds 10 (Group III), and 12 (Group IV) both have an amide that is substituted by alkyl groups in such a way that the alkyl groups form a ring with the nitrogen atom to which they are attached. Clearly one of ordinary skill in the art can see that all of the compounds in Groups I through IV share a single general inventive concept of an amide being substituted by alkyl or substituted alkyl groups. This is true when one considers that the Examiner has designated all of Groups I through V to be in classes 558, 562, etc. Groups I through V should therefore be rejoined. At the very least, Groups I and II should be rejoined.

The Applicants respectfully submit that the instant application complies with the requirement for unity of invention. As noted in the International Preliminary Examination Report, the International Preliminary Examination Authority did not find a lack of unity of invention. The Examiner is directed to PCT Article 27(1), which states "No national law shall require compliance with requirements relating to the form or contents of the international application **different from or additional** to those which are

provided for in this Treaty and the Regulations" (Emphasis added). It is respectfully submitted that the standards for unity of invention for the instant application during the national phase must not be "different from or additional to" those utilized by the International Search Authority (ISA) and International Preliminary Examination Authority (IPEA) during the international phase. Thus, it is respectfully submitted that unity of invention is not lacking, a result previously found by the ISA and IPEA and for this reason the restriction should be withdrawn.

Applicants further request that the Examiner apply procedures for the rejoinder of withdrawn method claims consistent with MPEP 821.04 (e.g. the Official Gazette Notice (1184 O.G. 86) of March 26, 1996, and the "Training Materials for Treatment of Product and Process Claims in Light of In re Brouwer and In re Ochiai and 35 U.S.C. 103 (b)"). Applicants note that the method claims already include all the limitations of the main product claim.

Respectfully submitted,

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